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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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08/169,127

12/20/1993

HISATO SHINOHARA

0756945

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22204 7590 09/07/2005

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EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**  
**After the Filing of an Appeal Brief**

Application No.

08/169,127

Examiner

Marianne L. Padgett

Applicant(s)

SHINOHARA ET AL.

Art Unit

1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

The reply filed 20 June 2005 is acknowledged.

1. ☐ The reply filed on or after the date of filing of an appeal brief, but prior to a final decision by the Board of Patent Appeals and Interferences, will not be entered because:

a. ☐ The amendment is not limited to canceling claims (where the cancellation does not affect the scope of any other pending claims) or rewriting dependent claims into independent form (no limitation of a dependent claim can be excluded in rewriting that claim). See 37 CFR 41.33(b) and (c).

b. ☐ The affidavit or other evidence is not timely filed before the filing of an appeal brief.  
See 37 CFR 41.33(d)(2).

2. ☐ The reply is not entered because it was not filed within the two month time period set forth in 37 CFR 41.39(b), 41.50(a)(2), or 41.50(b) (whichever is appropriate). Extensions of time under 37 CFR 1.136(a) are not available.

Note: This paragraph is for a reply filed in response to one of the following: (a) an examiner's answer that includes a new ground of rejection (37 CFR 41.39(a)(2)); (b) a supplemental examiner's answer written in response to a remand by the Board of Patent Appeals and Interferences for further consideration of rejection (37 CFR 41.50(a)(2)); or (c) a Board of Patent Appeals and Interferences decision that includes a new ground of rejection (37 CFR 41.50(b)).

3. ☒ The reply is entered. An explanation of the status of the claims after entry is below or attached.

4. ☒ Other: As per discussion in advisory of 5/25/05 & interview summary mailed 6/21/05, the remaining rejections of the 5/19/04 final rejection are overcome or made moot by the cancellations, however as indicated on 6/17/05 after search/update including non-elected species (Si oxide) that were requested to be rejoined, obviousness double patenting (ODP) rejection over Shinohara et al (6,261,856 B1) would be required & attached as it would include the rejoined claims. Note, for the rules as of 9/13/04, new ground are permitted (37 CFR 41.39) in an Examiner's Answer, where appellant may request reopening (41.39(b)). The Brief filed on 6/20/05 is non-compliant as discussed in the PTOL-462. Given the attached ODP rejection, applicants may wish to consider filing of a terminal disclaimer in lieu of amended brief &/or request for reopening.

*continued on next page.*

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## Attachment to Advisory Action after filing of Brief

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 61-96, 101-109 & 131 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39 of U.S. Patent No. 6,261,856 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the patent to Shinohara et al (856) were found to contain limitations of the remaining crystallization process claims, where limitations are claimed in different orders, such as in some patented independent claims the semiconductor is generic & in some its amorphous Si, where present claims are all directed to the specific species (a-Si), to make obvious variations of overlapping scope. It was noted that the insulating (Si Oxide & Si Nitride) layers (claims 1, 6, 17 & 24) therein may be called "blocking layers" (claims 27-28 & 33-34) without "ion", but the ion blocking function is inherent or obvious by context of like configurational placement of like compositions in the claimed "active matrix circuit and driving circuit", especially considering that the patent derives its support for its terms' meaning from the same disclosure as the present case. Note present independent claim semiconductor film thickness of 200-1500 angstroms is in patent claim 8, where use of the thickness for generic semiconductor films, would have been obvious to apply also to the a-Si claimed in other sequences, as it is the only specific species claimed before crystallization is preformed, hence would have been expected to be applicable thereto by one of ordinary skill in the art.

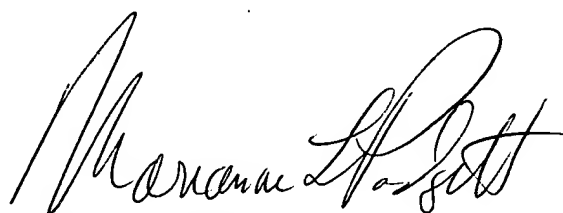
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne L. Padgett whose telephone number is (571) 272-1425. The examiner can normally be reached on M-F from about 8:30 a.m. to 4:30 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks, can be reached at (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MLP 9/4/05

A handwritten signature in black ink, appearing to read 'Marianne Padgett', is written in a cursive style.

**MARIANNE PADGETT**  
**PRIMARY EXAMINER**

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|--|--|---|--|
| <b>Notification of Non-Compliant Appeal Brief<br/>(37 CFR 41.37)</b> | <b>Application No.</b><br>08/169,127   | <b>Applicant(s)</b><br>SHINOHARA ET AL. |  |
|  | <b>Examiner</b><br>Marianne L. Padgett | <b>Art Unit</b><br>1762                 |  |

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

The Appeal Brief filed on 20 June 2005 is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.

**EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.**

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☐ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☒ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner and **relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☒ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

The examiner has been told that all briefs MUST contain the appendixes of sections 8 & 9, above, even if they only state there is no evidence or no decisions.

  
**MARIANNE PADGETT**  
**PRIMARY EXAMINER**